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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,894	03/30/2004	Hiroyuki Gennami	5000-5158	7615
7590	08/21/2006			EXAMINER
MORGAN & FINNEGAN, L.L.P. 345 Park Avenue New York, NY 10154				TRIEU, THERESA
			ART UNIT	PAPER NUMBER
				3748

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/814,894	GENNAMI ET AL.	
	Examiner Theresa Trieu	Art Unit 3748	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 June 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4, 11-16, 23 and 24 is/are rejected.  
 7) Claim(s) 5-10 and 17-22 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                             |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                        | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

This Office Action is responsive to the applicants' amendment filed on June 13, 2006.

Claims 1, 10, 13 and 22 have been amended. Accordingly, claims 1-24 are pending in this application.

Applicants' cooperation in correcting the informalities in the specification is appreciated.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Regarding claims 1, 2, 4, 11, 13, 14, 16 and 23, as shown in Fig. 3, Arata discloses an electric compressor, comprising: an electric motor (7) having an axis of rotation; a compression mechanism (2, 3) that is driven by the electric motor to compress gas, wherein the compression mechanism includes a suction chamber (2a); a housing for accommodating the compression mechanism, wherein the housing defines a motor accommodating chamber (11) that accommodates the electric motor such that the rotation axis of the motor is substantially horizontal, and wherein the pressure in the motor accommodating chamber is equal to the pressure in the suction chamber; and a connecting passage (20, 23a, 23) for connecting the lowest portion of the motor accommodating chamber with the suction chamber (2a); the compression mechanism being of a scroll type and includes: a stationary scroll (4) having a base plate and a volute portion, wherein the base plate is fixed to the housing; and a movable scroll (3) having a base plate and a volute portion, wherein the movable scroll, together with the

stationary scroll, defines a compression chamber (2c) between the volute portions, wherein the motor causes the movable scroll to orbit so that the compression chamber is moved toward the center of the volute portions while decreasing the volume, whereby gas is compressed; the base plate of the movable scroll having a first face and a second face, the volute portion extending from the first face, and the second face being opposite from the first face (see Fig. 3), wherein a partition member (5) is located in the housing to face the second face, wherein the second face and the partition member define a back pressure chamber (not numbered; however, clearly seen in Fig. 3), wherein an elastic body (1b) is located between the second face and the partition member, the elastic body urging the movable scroll toward the stationary scroll, and wherein the elastic body seals the back pressure chamber and the suction chamber from each other; in the motor accommodating chamber, a recess (not numbered; however, clearly seen in Fig. 3) being formed in a lower part of the housing that is located below the motor (7).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arata in view of Yamada et al. (Yamada) (Patent Number 5,468,130).

Arata discloses the invention as recited above; however, Arata fails to disclose the surface of the movable scroll being plated with nickel phosphorus.

Yamada teaches that it is conventional in the art to utilize the movable scroll member being coated with nickel phosphorous. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the surface of the movable scroll being plated with nickel phosphorus, as taught by Yamada in the Arata apparatus, since the use thereof would have improved the wear resistance.

3. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arata in view of design choice.

Arata discloses the invention as recited above; however, Arata fails to disclose the compressor being used in a vehicle air conditioner. It is examiner's position that one having ordinary skill in the electric scroll compressor art, would have found it obvious to utilize the compressor being used in a vehicle air conditioner, since they are merely design parameters depending on being used for a particular purpose or solving a stated problem. Moreover, there is nothing in the record which establishes that the claimed scroll compressor for a vehicle air conditioner, presents a novel or unexpected result (See *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975)). Note that in claim 12 and 24, the limitation "being used in a vehicle air conditioner" is an intended use. A recitation of the intended use of the claimed invention must

result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

***Allowable Subject Matter***

4. Claims 5-10 and 17-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicants' arguments filed on June 13, 2006 have been fully considered but they are not persuasive.

With regard to applicants' argument that Arata does not teach/suggest the amended limitation that is "a connecting passage for connecting the lowest portion of the motor accommodating chamber with the suction chamber" (see Remarks section, pages 99-11). The Examiner disagrees.

The "*lowest portion*" is a relative term which does not define a specific location with respect to the suction port (12f)/sealed space (14)/axis rotation of the motor (23)/shaft supporting member(15). Accordingly, Arata clearly teaches the connecting passage (20, 23a, 23) for connecting the lowest portion of the motor accommodating chamber (11) with the suction chamber (2a). Since claims 1 and 13 just simply recite a "*lowest portion* of the motor

“accommodating chamber” without additional limitations to define a reference point such as, with respect to the suction port (12f), it is reasonable, giving the broadest interpretation for the examiner to assert that the chamber (11) around the connecting passage (20, 23a, 23) is “lowest portion of the motor accommodating chamber” depending on the viewing position of the orientation of the scroll compressor.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a recesses (12e, 24d) form a connection passage; a connection passage is in the lowest portion of the motor accommodating chamber) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TT  
August 17, 2006

  
Theresa Trieu  
Primary Examiner  
Art Unit 3748